

Application No. 10/602,506
Amdt. Date June 27, 2006
Reply to Office Action dated December 27, 2005

Remarks/Arguments

Claim Rejections 35 USC 102(b)

7.

As stated in *W. L. Gore Associates v Garlock*, 721 F.2d 1540 "anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration".

Lindemann Maschinenfabrik GMBH v American Hoist and Derrick Co, 730 F.2d 1452, states: "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged* as in the claim"

The Federal Circuit has further indicated that "in deciding the issue of anticipation, the trier of fact must identify the element of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." *Id.*, 221 USPQ at 485.

Further, "under, 35 U. S. C. Section 102, anticipation requires that...the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." *Akzo N. V. v United States Int'l Trade Commission*, 808 F.2d 1471.

Similarly, the Federal Circuit has stated: "An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention." *ATD Corp. v Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321, 1328.

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"There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found v Genentech inc.*, 927 F.2d 1471.

"A device which does not operate on the same principle cannot be an anticipation." *Los Alamitos Sugar Co. v Carroll*, 173 F2d. 280, 284 (9th Cir. 1909).

"It is not sufficient, in order to constitute an anticipation of a patented invention, that the device relied upon might, by modification, be made to accomplish the function performed by that invention, if it were not designed by its maker, nor adopted, nor actually used for the performance of such function." *Topliff v. Topliff et al.*, 145 U. S. 156.

"The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention. "Crown Operations Int., Ltd. v Solutia Inc., 289 F3d. 1357, 1375.

Under section 35 U.S.C. 102(b), the invention that has been offered for sale or in public use must, of course, be something circumscribed by metes and bounds of the claim.

Graver Tank & Mfg. Co v Linde Air Prods., Co., 339 U.S. 605,607. Therefore, the first determination in the Section 102 (b) analysis must be whether the subject of the barring activity met each of the limitations of the claim. *Scaltech Inc. v Retec/Tetra L.L.C.*, 178 F.3d 1953.

A reference must generally place the needed subject matter supporting the anticipation rejection in the public domain before the date of invention. *In re Zenitz*, 333 F.2d 924, 142 USPQ 158, 160 (CCPA 1964). Thus, a prior art reference, including a printed

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publication, must be enabling as required for US patents under 35 U.S.C. Section 112, first paragraph. *Paperless Accounting, Inc. v Bay Area Rapid Transit Sys.*, 804 F.2d 659,665.

The description must enable a person with ordinary skill in the art not only to comprehend the invention but also to make it. *Paperless Accounting, Inc. v Bay Area Rapid Transit Sys.*, 804 F.2d 659,665.

In *Elan Pharmaceuticals Inc. v Mayo Foundation for Medical Education and Research*, the Federal Circuit clarified that the invalidity based on anticipation requires that assertedly anticipating disclosure enable the subject matter of the prior art reference, and thus of the patented invention, without undue experimentation.

As stated by the Federal Circuit, the prior art reference must disclose each element of the claim "arranged as in the claim" *Lindemann Maschinenfabrik GMBH v American Hoist and Derrick Co.*, 730 F.2d 1452

The Office Action must provide a reasonable basis asserting that the prior art reference under Subsection 102 (a) (b) (c) (d) (e) or (g) contains the claimed subject matter as arranged in the claim of the application.

A holding of no anticipation may be found in instances where the general subject matter is the same, but the specific application or use is different. *Union Oil Co of Cal. V Atlantic Richfield Co.*, 208 F.3d 989

The Federal Circuit has ruled that "the prior art reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. *In re Spada*, 911 F.2d 705, 708

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1. Claims 1 and 73: the evidence material in Masi patent is only incidentally "evidence material". Its primary purpose is to generate light, illuminate the scene, call attention to the incident and help point to the assailant.

"There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v Genentech inc.*, 927 F.2d 1471. The Masi patent is different from the claimed invention as the invention specifically seeks to identify the assailant.

2. Claim 2. The vessel in Masi is a complex apparatus containing many components and designed to carry a deterrent spray, strobe light and light generating chemicals. As such, it is different from the invention.

3. Claims 3 and 4 cancelled.

4. Claim 5: 710 in Fig. 7 of Masi does not describe open or partially open vessel.

5. Claim 6: cancelled.

6. Claim 7: currently amended.

7. Claim 8: currently amended. Claims 13-14, 16. Masi patent does not disclose leak indicating fluid, but merely talks about alternatives to the glowing fluid.

8. Claim 9: currently amended

9. Claim 12: cancelled

10. Claim 15: Masi patent addresses different types of glowing fluids and alternatives, not the types of particles added for identification purpose as in this invention.

A holding of no anticipation may be found in instances where the general subject matter is the same, but the specific application or use is different. *Union Oil Co of Cal. V Atlantic Richfield Co.*, 208 F.3d 989

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Claim 21: same comment as claim 15.

11. Claim 18: same comment as claim 15.

12. Claim 19: same comment as claim 15.

13. Claim 20: cancelled

14 Claims 22-27, 30

Materials in Masi are alternatives to the glowing fluid without any emphasis on identification codes, physical markers, etc. that would make materials easily traceable.

"There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v Genentech inc.*, 927 F.2d 1471. The Masi patent is different from the claimed invention as the invention specifically seeks to identify the assailant.

15. Claim 28: cancelled

16. Claim 29: amended

17 Claim 33:

As stated by the Federal Circuit, the prior art reference must disclose each element of the claim "arranged as in the claim" *Lindemann Maschinenfabrik GMBH v American Hoist and Derrick Co*, 730 F.2d 1452

A holding of no anticipation may be found in instances where the general subject matter is the same, but the specific application or use is different. *Union Oil Co of Cal. V Atlantic Richfield Co.*, 208 F.3d 989

The Federal Circuit has ruled that "the prior art reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. *In re Spada*, 911 F.2d 705, 708

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Masi patent serves to deter by pepper spray or similar action, employees strobe light and glowing fluid. Claim 33 claims a device that is designed with the specific purpose of being capable to remove and store portions of assailants skin, bone, hair, tissue, bone or body fluids. Masi patent does not mention any of these functions, nor does the Office Action point out why they would be inherent to Masi patent. The use of Masi patent is different from this invention. The Masi patent neither discloses the tool of the Claim 33 nor are the elements of the Masi patent arranged as in the claim 33. The device in claim 33 obtains the assailants samples as a result of struggle with the victim and independently of the victim's acts. The pin and other portions of Masi device require purposeful striking of the attacker by the victim.

Claims 60: amended

Claim 61: please see Claim 33 argument.

18. Claim 34: this device is completely different from the ampule in Masi and it does not contain the evidence material.

19. Claim 37: (currently amended) please see Claim 33 argument. Additionally, Masi device is designed to only spray and leave some fluids on the attacker, not to store.

20. Claim 45: the tool of this invention is very different from the ampule nozzle, nor does Masi call for the bleed channel (please see claim 33 argument).

21. Claim 62: the pin 28 is visible as it extends beyond the body of the Masi device.

Also, per the claim 33 argument, the pin is not a tool for obtaining samples.

22. Claims 66, 67: cancelled

23. Claim 70: Masi 18 is safety cap, different function from removable cover of this invention. A holding of no anticipation may be found in instances where the general

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subject matter is the same, but the specific application or use is different. Union Oil Co of Cal. V Atlantic Richfield Co., 208 F.3d 989

24. Claim 84: please see claim 33 argument. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." Scripps Clinic & Research Found. v Genentech inc., 927 F.2d 1471. Pin 28 is a safety pin and the device of this invention is designed to penetrate.

25. Claim 95: to activate the Masi patent one need to: pull a pin and squeeze the trigger. The breaking in this invention does not require any such actions.

26. Claim 96-amended, claim 97: amended.

9.

These claims have been cancelled independent of Van Luit.

10.

These claims have been cancelled independent of Porter.

11. Claims 1-2

A holding of no anticipation may be found in instances where the general subject matter is the same, but the specific application or use is different. Union Oil Co of Cal. V Atlantic Richfield Co., 208 F.3d 989

Charlot is designed to prevent theft of clothing or similar articles and embodies a complicated mechanisms requiring pin 14 and clutch 16 for holding together portions of the device and vials that fracture when flexed longitudinally. The intended use of pin 14 is therefore not to obtain and store samples. The vials contain chemicals that harm

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potential thief. This invention aims for the exact opposite. Furthermore, the pin 14 is not designed to separate from the device so that it can be used to collect or retain samples.

"There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v Genentech inc.*, 927 F.2d 1471.

Claim 84: cancelled

Claim Rejections – 35 USC section 103

Relying on MPEP (8th Edition) 706.02(j)(A)(B)(C)(D) for standards of obviousness and the following cases:

To establish the *prima facie* case of obviousness, the basic criteria need to be met:

1. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of the ordinary skill in the art to modify the reference or to combine the reference teachings.
2. Second, there must be a reasonable expectation of success.
3. The prior art reference (or references when combined) must teach all the claim limitations.

The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not

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based on the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed Cir 1991).

Furthermore, the reference must be either in the field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986)

A reference is reasonably pertinent ifit is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering the problem....If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem...if it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. In re Clay, 966 F.2d 656, 23 USPQ2d 1058, 1060 –61 (Fed. Cir. 1992).

The Federal Circuit has also added the following when determining whether the reference is within the inventor's endeavor:

We have reminded ourselves and the PTO that it is necessary to consider "the reality of circumstances' – in other words, common sense – in deciding in which field a person of ordinary skill would reasonably be expected to look for solution to the problem facing the inventor. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992, quoting In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)

13.

1. Claim 10: Masi does not teach all the claim limitations of claim 10.
2. Claim 11: please see claim 10 comment. Also, the purpose of plastic in this invention is to rub against the attacker and collect samples. This purpose is different from the Masi.
3. Claim 31: cancelled
4. Claim 32: cancelled
5. Claim 35: Masi does not teach all the claim limitations of claim 35.
6. Claim 65: amended
7. Claim 68: cancelled
8. Claim 69: Masi does not teach all the claim limitations of claim 69. In

this invention the vessel expands outwardly in the direction of cutting tools rather than being crushed upon activation by the trigger in Masi.

14. Claims 55-57 and 59: cancelled.
15. Claims 63-64: cancelled.
16. Claims 77 and 79: cancelled.
17. Claims 85 – 89 cancelled.

Claim 85 cancelled.

Claim 86 amended.

A reference is reasonably pertinent ifit is one which, because of the matter with which it deals, logically would have commended itself to the inventor's

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attention in considering the problem....If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem...if it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. In re Clay, 966 F.2d 656, 23 USPQ2d 1058, 1060 –61 (Fed. Cir. 1992). The Perreau reference is not pertinent as it serves the purpose of showing that an item has not been removed without the RFID tag having been from the device, i.e., to reduce theft. In this invention the purpose of the RFID tag is to stay on the attacker and the victim and hopefully aid in the attacker's capture. These two purposes are different.

The Federal Circuit has also added the following when determining whether the reference is within the inventor's endeavor:

We have reminded ourselves and the PTO that it is necessary to consider "the reality of circumstances' – in other words, common sense – in deciding in which field a person of ordinary skill would reasonably be expected to look for solution to the problem facing the inventor. In re Oetiker, 977F.2d 1443, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992, quoting In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)

The RFID tag of this invention would not require employing printed circuit board technology as in Perreau.

Claims: 87-89 . Same comments as for the claim 86.

Claims: 102-107, 112 –115: cancelled

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Claim 75: cancelled

Claims: 110-111 cancelled.

Claims 116-118 cancelled.

18. Claims 100 – 101. Charlot teaches an item for preventing theft of clothing and damaging the same. The purpose of Charlot and this invention are not the same. In re Clay, 966 F.2d 656, 23 USPQ2d 1058, 1060 –61 (Fed. Cir. 1992). Moreover, Charot does not teach all the limitations of claims 100-101, e.g., the “strength of the attachment devices exceeding the vessel breaking strength.”

MPEP (8th Edition) 706.02(j)(A)(B)(C)(D)

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~~Amend. Date March 3 2004 Preliminary Amendment~~

~~AMENDEMENT TO THE SPECIFICATION~~

~~On Page 10 add the following after the brief description of Fig. 58~~

~~Fig. 59 is a wireless or radio frequency identification device with attachment capability.~~

~~Fig. 60 is a wireless or radio frequency identification device with sample taking capability.~~

~~Fig. 61 is a wireless or radio frequency identification device with penetrating capability.~~

~~Fig. 62 is a wireless or radio frequency identification device with combined penetrating and sampling capability.~~

~~Fig. 63 shows multiple sampling devices~~

~~Fig. 64 shows the sample taking detail~~

~~Fig. 65 is a side view of the device of Fig. 63~~

~~The paragraphs in the application as filed were not numbered. The paragraph numbers if added in this correspondence are for purposes of clarification.~~

~~ON PAGES 31 AND 32 replace the description of Fig. 55~~

~~[003] Another embodiment of the skin penetrating device is shown in Fig. 55 where the device 940 also has a wireless device or radio frequency identification device 936 in addition to the identity code 934. Presence of wireless device or radio frequency identification device 936 makes it possible to detect the presence of the attacker or the victim whenever they pass through a proper detector or electromagnetic field. The identity of the device 936 is then communicated to the host computer for processing and enabling easier location of the attacker and the victim.~~

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~~The radio frequency identification device or a wireless device 936 may also include an antenna. Moreover, the radio frequency identification device or wireless device 936 may be covered with shielding material that attenuates or completely blocks electromagnetic signals. This would prevent the attacker from finding the devices 936 with a suitable detector after the attack, collecting them and erasing the evidence of his presence. The shielding material may include water and salt solution, Aloe Vera gel, iron particles and similar. The shielding material preferably adheres to the radio frequency identification device or wireless device 936 for improved effectiveness. Not all of the radio frequency identification devices or wireless devices need to be covered with the shielding material. This option would enable the attacker to collect the ones which are not shielded if he has suitable detection equipment and create a false belief that he has collected all the identification devices, and is therefore safe, thus making his capture more likely. Preferably, the shielding material would degrade when exposed to air. At least some of the radio frequency identification devices or wireless devices would become exposed to air during the struggle with the attacker. Materials, such as Aloe Vera gel would dry and lose their shielding ability. The attacker would now be at risk of being detected whenever he enters an area monitored by proper search devices. The vessel housing the radio frequency identification devices or wireless devices may be labeled with a warning for increased deterrent effect. The radio frequency identification device~~

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~~or wireless device 936 may operate independently by itself or it may be combined with a vessel. For increased effectiveness, radio frequency identification device or wireless device 936 may also includes a mechanical identification code scribed or otherwise imprinted on or into the device 936 or it may have an electrical code. The mechanical or electrical identification code could be unique to each device 936 or the code may be shared by multiple devices 936. Any off the shelf commercially available radio frequency identification devices or wireless devices may be emplnved. The wireless or radio frequency identification device 936 may also be employed on any of the tools for taking samples of skin, tissue, bone, body fluids or hair as described in this specification, in any of the vessels containing evidence materials or in evidence materials themselves. If the device 936 is a radio frequency identification device, [[The]] the device 936 may be electrically active or electrically inactive. Active radio frequency identification device is powered by an internal battery which enables it to have greater read range, thus enabling an easier detection of a person with such device on them. Electrically inactive devices do not have their own power source but operate from the power generated by the read device. This gives them essentially unlimited life, however, they do suffer from short read range, making it more difficult to detect a victim or the attacker with such device on them.~~

On PAGE 33 add the following paragraphs where the description of Fig. 58 ends with the word "the attacker" in paragraph [001]:

[002]— Fig. 59 shows a wireless or radio frequency identification device 936 having the body 1002 and the extensions 1006. The extensions 1006 enable the device 936 to attach itself to the attacker' person, clothing or other effects and so aid in his identification and capture.

Fig. 60 is a wireless or radio frequency identification device 936 having the body 1002 and further equipped with sample obtaining sections 1006 extending outwardly from the body 1002 and terminating with sharp points 1008 and 1010 and sample storing section 1012. The sharp points 1008 and 1010 make contact with and penetrate the attacker's skin or other parts of his body and retain a sample of the attacker's skin, bone, hair, tissue or bodily fluids on sharp points 1008 and 1010 or in the section 1012, and so aid in the attacker's identification and capture.

Fig. 61 shows a wireless or radio frequency identification device 936 with the body 1016, sharp point 1020 and the blunt end 1022. In the course of struggle between the attacker and the victim, the force applied to the blunt end 1022 forces the sharp point 1020 to penetrate the attackers body or clothing. The wireless or radio frequency identification device 936 will therefore tend to stay imbedded in the attacker and so aid in his identification and capture.

~~A wireless or radio frequency identification device 936 may combine the sample obtaining capability described in Fig. 60 with the penetrating capability described in Fig. 61. An example of this embodiment is shown in Fig. 62 where the device 936 has the body 1016, blunt end 1022, sharp points 1008 and 1010 and storage chambers 1018. The device 936 may remain embedded in the attacker, but if not, storing samples of the attacker's skin, bone, tissue or bodily fluid samples in the chambers 1018 aids in the identification of the attacker.~~

~~Fig. 63 shows an alternate embodiment 1030 that utilizes at least one, but preferably several tissue sampling devices. The device 1030 includes the body 1048 which is typically shaped in form of a disc with or without air space between two major surfaces, outer edge 1042 of the body 1048, projections 1044 for taking and storing skin samples, vent openings 1046, a mechanical identification code 1040 unique to each device or a number of devices shares a unique or small number of identification codes, preferably a wireless or radio~~

~~Radio frequency identification device 936 and preferably one of the major surfaces of disc shaped body 1048 is visually very distinct from other surfaces. The details of projections 1044 are shown in Fig. 64 where 1060 and 1062 are sharp points and 1066 is a storage space for skin samples.~~

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~~As the device 1030 makes contact with skin of the attacker it collects skin samples with projections 1044 and stores the samples in storage space 1066.~~

~~Vent openings 1046 allow for air to escape and so enable easier storage of attacker's and victim's skin samples in storage space 1066.~~

~~Fig 65 is the side view of the device 1030 showing two major surfaces 1070 and 1072. The surfaces 1070 and 1072 may enclose air space or have solid material between them. In case where solid material is utilized, each projection 1044 would require its own vent opening 1066. Preferably one of the two surfaces 1070 and 1072 is visually very distinct from the other.~~

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Delas', with a stylized, cursive script.

Anthony Delas
Reg. No. 49,067